

REMARKS

Rejections under 35 USC § 112, second paragraph

Claim 12 was rejected under 35 USC § 112, second paragraph, for allegedly failing to particularly point out and claim the subject matter of the invention. More specifically, the recitation of "organic particle" was deemed indefinite. Claim 12 has been amended to refer to "inorganic particles"; this amendment merely corrects a typographical error.

Applicants disagree with the assertion in the Office Action that Claim 50 is a substantial duplicate of Claim 19. While there is overlapping subject matter in the claims, they are not identical.

Rejections Under 35 USC § 102(b)

Claims 1-7, 9, 13 and 15-27 were rejected under 35 USC § 102(b) as allegedly being anticipated by Stubbs et al. (U.S. Patent No. 5,595,578). This rejection is respectfully traversed.

Stubbs is cited as disclosing coated abrasives prepared using various abrasive particles in the 0.1 to 1500 micrometer range. The coated abrasives of Stubbs, however, are decidedly different from the coatings of the present invention. More specifically, Stubbs is directed to an abrasive material, in contrast to a coating that exhibits abrasion resistance. The coated abrasives of Stubbs are abrasive paper, such as that used by Applicants in the scratch resistance testing described in the Example section of the present application. The abrasives are prepared by sprinkling relatively large abrasive materials on top of a hot melt polyurethane. Thus, the particles are not dispersed through the resin, as presently claimed and described at page 11, lines 25-28. Thus, the abrasives of Stubbs do not anticipate the present coatings.

Claims 1-7, 9, 13, 15-27 and 30-33 were rejected under 35 USC § 102(b) as allegedly being anticipated by Samuelson (U.S. Patent No. 4,048,765). This rejection is respectfully traversed.

As noted in the Office Action, Samuelson discloses a non-cellular polyurethane wheel made from, *inter alia*, abrasive grains. A polyurethane polishing

and finishing wheel having abrasive grains imbedded therein does not anticipate a coating comprising such particles. Samuelson does not appear to teach a coating at all. As such, the reference does not anticipate the present claims.

Rejections under 35 USC § 103(a)

Claims 1-7, 9-27, 29 and 42-50 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Stubbs; Claims 1-7, 9-33 and 42-50 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Samuelson. Both of these rejections are respectfully traversed.

The Office Action states that the disclosures in the patents "prove that it would have been obvious to follow their teaching and arrive at [the] above claimed invention." Applicants respectfully submit that there is no proof of this whatsoever. The cited references are generally directed to sandpaper and a polishing wheel, respectively. Neither reference even remotely teaches or suggests the coatings of the present invention.

The Office Action specifically notes that Claims 10-12 would have been obvious in light of the references, even though the references are silent as to the types of alumina recited in these claims, because such alumina is known. Use of various forms of alumina in the sandpaper of Stubbs or the polishing wheel of Samuelson, however, would still not result in the present invention. The Office Action also states that it would be obvious to prepare a coating in solid or liquid form; Applicants submit that one skilled in the art would readily attest to the fact that powder coating technology and liquid coating technology are not necessarily readily interchangeable.

The Office Action further states that Claims 42-50 encompasses certain limitations that are not disclosed by the references, but that would be inherently satisfied by the art. Again, since neither of the references teach the coatings recited in these claims, they cannot be said to inherently satisfy the limitations of the claims. For example, the gloss reduction and retention recited in several of the

claims would be completely irrelevant to the sandpaper taught by Stubbs and the polishing wheel taught by Samuelson.

Claim 8 was rejected under 35 USC § 103(a) as allegedly being unpatentable over either Stubbs or Samuelson and further in view of Diener et al. (U.S. Patent No. 5,614,250). This rejection is respectfully traversed.

The Office Action concedes that Stubbs and Samuelson fail to disclose the three types of silica recited in Claim 8; Diener is cited as allegedly disclosing coated fillers including silica. There is no teaching or suggestion in any of the references, however, that they be combined to arrive at the present invention. Again, neither Stubbs nor Samuelson teach a coating according to the present invention; the use of silica particles as taught by Diener in either Stubbs or Samuelson, therefore, would still not result in the present invention. Moreover, Diener teaches use of silica coated with fluorosilane as a filler, not as an abrasive particle. Neither Stubbs nor Samuelson, if looking for alternative abrasive particles, would have been motivated to look to Diener.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT


Applicants note that a Supplemental Information Disclosure Statement was filed on January 6, 2003. Applicants respectfully request that a copy of the Form 1449 be returned to Applicants, indicating that the Examiner has considered the references cited therein. EP 1 038 927 A2, identified in the Supplemental Information Disclosure Statement, appears to be related to U.S. Patent No. 6,362,267 B1, and WO 00/52105 to U.S. Patent No. 6,399,689 B1. In addition, Applicants file herewith an additional Supplemental Information Disclosure Statement. The document listed on that Statement recently came to the attention of Applicants, as will be apparent from its publication date. As such, no fee is due pursuant to 37 CFR § 1.97(c)(1).

SUMMARY

For all of the reasons given above, it is submitted that the presently pending claims are allowable over the cited art. A Notice of Allowance is respectfully requested at an early date.

Respectfully submitted,

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